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09/827,950	04/09/2001	Masahiro Nakano	SOA-330	6685
23353	7590	08/10/2005	EXAMINER	
RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036			BUI, KIEU OANH T	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 08/10/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/827,950

Applicant(s)

NAKANO, MASAHIRO

Examiner

KIEU-OANH T. BUI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Claim Rejections - 35 USC 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

*(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

2. Claims 1-4, and 6-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Kung et al. (U.S. Patent No. 6,373,817 B1).

Regarding claim 1, Kung discloses “an apparatus for filtering electronic mail and notifying a user, residing in a set top box connected between a television content provider, an Internet provider having an e-mail server, and a television” (Fig. 1, for users at terminals 142 or wireless 144 or users at CPE Home 102 –a set top box- with an integrated broadband residential gateway BRG 300 interface or module (Fig. 3, with P1-P6 are processors for processing software program applications, refer to col. 21/line 54 to col. 22/line 36) receiving contents including e-mails from the Internet 180 via an Internet provider or Administration 155 connected to an IP central station 200, with a television content provider at head end hub 115, terminals including a television, a set top terminal or a set top box, refer to col. 4/lines 22-60 & col. 19/lines 9-26), comprising:

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a software program application which enables a user specify filter criteria and notification icons which then retains and stores said e-mail filter criteria and icons; a querying module contained within said software program application which queries said e-mail server to determine whether e-mail fulfilling said e-mail filter criteria has arrived at said e-mail server (Figs. 7a, 8 & 10 for a software program allowing the user to define and set up a calling schedule for himself/herself or a calling preference in filtering e-mail or message intended for him/her and for the server to know whether to retain and store the message, see Fig. 2 and col. 13/lines 7-26 for a multimedia server 222 for e-mail supports; col. 34/line 20 to col. 35/line 5 for chase me feature; and col. 35/line 44 to col. 36/line 35 for filtering and scheduling of calls or messages); and a notifying module also contained within said software program application wherein, upon arrival of an e-mail fulfilling said criteria, said application notifies the user by posting said notification icons to the set top box, i.e., col. 29/lines 27-44 for a query addressed; and col. 30/lines 15-31 for call or message alerting; and col. 23/lines 4-22 for an instant message included.

As for claims 2 and 3, Kung discloses “wherein the connection between said set top box and said mail server is permanent, so that said application continually queries said e-mail server” and “wherein the connection between said set top box and mail server is non-permanent, so that said application queries said e-mail server at specific timed intervals”, i.e., depending on the user’s preference whether to receive the e-mail or message notification from the server continually or at specified time intervals, the application is performing as shown in Figure 10 whether to accept the message or filter the message at any time of day and any day of week (Fig. 10, and col. 35/line 44 to col. 36/line 35).

As for claim 4, Kung further discloses “wherein said set top box contains an multi-tasking Operating System and said application runs on top of said Operating System” (col. 21/line 34 to col. 22/line 25 for a multi-tasking operating system).

As for claims 6 and 7, Kung shows “wherein said application further includes means for notifying the user of the existing e-mail messages fulfilling said e-mail filter criteria through a notification icon on the television screen” and “wherein said notification icon is configurable by the user, and reflects the content of the e-mail filter criteria” (col. 22/line 37-col. 23/line 22 for status screen with icons and messages or e-mail notifications).

As for claims 8 and 9, Kung further discloses “wherein said application further includes means for notifying the user through the use of an tone generated through the television speaker” and “wherein said tone is configurable by the user, and reflects the content of the e-mail filter criteria” (col. 22/line 37-col. 23/line 22 for status screen with icons and messages or e-mail notifications; and col. 30/lines 15-30 for audio tones alerts).

As for claim 10, Kung shows “wherein said notifying means notifies the user of a plurality of said e-mail messages wherein each e-mail message satisfies different filter criteria and has a different user notification icon” (Figs. 7a & 7b & 8 for different filter criteria; and col. 22/line 45-63 for different icons addressed).

As for claim 11, Kung discloses “wherein said application further includes means for querying said e-mail server upon power-up of said set box, and immediately notifies the user of the existence any e-mail messages satisfying the user-specified e-mail filter criteria” (col. 30/lines 15-52 as notification is delivered to the user as soon as the off-hook network connection-power off- is connecting to the network again).

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As for claim 12, Kung discloses “wherein said application notifies the user via a pager rather than through said set top box” (col. 38/lines 13-36 for pager and notification to the user’s pager).

As for claim 13, Kung discloses “wherein said application notifies the user of the existence a telephone call with Caller ID satisfying said filter criteria, instead of an e-mail message” (col. 22/lines 37-49 for caller ID).

As for claim 14, Kung discloses “wherein said application notifies the user of another user attempting to make Instant Message contact with said first user” (col. 22/line 58 to col. 23/line 22 for instant message addressed).

As for claim 15, Kung shows “wherein newer versions of said application are downloaded to said set top box by said Internet provider” (col. 36/lines 5-35 as missing plug-ins or software can be downloaded to the set top box from the service provider).

As for claim 16, Kung discloses “wherein said downloading of newer versions can distinguish between different types of set top boxes, and make adjustments to content said download accordingly”, i.e., each user of the set top or terminal has their own ID for billing purposes and ordering including authentication for use within the network, see col. 12/lines 1-15; And col. 36/lines 18-35 as newer versions or new plug-ins or software can be requested and charged or free of charge based on available services from the service provider.

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As for claims 17 and 18, Kung shows “wherein said application is not resident on said set top but resident on said e-mail server” and “wherein said set top box is connected to said e-mail server through a middle server, where said application resident on said middle server” (Fig. 2 shows an IP central control with multimedia server 222 for e-mail as noted above; and the process is performed at the IP central station, see col. 7/line 35 to col. 8/line 60).

Regarding claim 19, Kung discloses “a method of filtering e-mail messages and notifying a user, comprising: installing a software program on a set box, wherein said set top box connected both to a TV content provider and an e-mail server; configuring said program with specific e-mail criteria and notification symbols; queuing incoming e-mail messages at said e-mail server; querying said e-mail server as to whether any of said queued messages fulfill said criteria; notifying a user that e-mail messages fulfilling said criteria are available on said e-mail server” (refer to claims 1-4 above).

Regarding claim 20, Kung discloses “an e-mail filtering and notification application, comprising: a set top box, connected between TV content provider, an Internet provider having an e-mail server, and a user-input means for allowing a user specify e-mail filter criteria and notification icons; retaining and storing means for retaining and storing said criteria and icons; querying means, for querying said e-mail server to determine whether e-mail fulfilling said user criteria has arrived at said e-mail server; notification means for notifying the user said arrival by posting said notification icons the Set Top Box, wherein said notification icons relate to the subject matter of said arriving email” (refer to claims 1-4 and 6-7 above).

Regarding claim 21, Kung discloses “an software application for filtering electronic mail and notify a user, residing on a set top box connected between a television content provider, an Internet provider having an e-mail server, and a television, comprising: said software program application enabling a user to specify e-mail filter criteria and notification icons which then retains and stores said e-mail filter criteria and icons; a querying module which queries said e-mail server to determine whether e-mail fulfilling said e-mail filter criteria has arrived at said e-mail server; a notifying module wherein, upon arrival of an e-mail fulfilling said criteria, said application notifies the user by posting said notification icons to the set top box” (refer to claims 1-4 above).

***Claim Rejections - 35 USC 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kung et al. (U.S. Patent No. 6,373,817 B1) in view of Skinner et al. (U.S. Patent No. 6,397,167 B2).

Regarding claim 5, Kung does not suggest the step of “wherein said set top box contains an single-tasking Operating System and said application remains memory as a Terminate and Stay Resident (TSR) program and runs intermittently at user-configurable intervals”; however, this is so well known in the art. In fact, Skinner teaches a same technique in using TSR program for memory applications within the set top box, and the user controls and runs intermittently at



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user-configurable intervals (see Skinner, col. 8/line 43 to col. 10/line 36 for windows applications and TSR programs addressed). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Kung's system with Skinner's detailed technique in TSR programs in order to provide applications to the system at the user's configurable intervals, for instance, at the user's keystroke or input as taught by Skinner.

### ***Response to Arguments***

5. Applicant's arguments filed on 05/20/05 have been fully considered but they are not persuasive.

Applicant argues that Kung does not teach or disclose an apparatus for filtering e-mail and notifying a user residing in a set top box, installing a software in a set top box, and a software program application residing on a set top box as cited in claims 1, 19, and 21 by pointing out to an IP central station. However, the Examiner would like to invite the applicant to take a closer look of Fig. 1 as CPE Home item 102, which can be integrated with broadband residential gateway BRG 300 interface; and refer to Figure 3 of a detailed view of the BRG 300, this interface module comprising many services and applications for getting the calls, setting up the calls, or getting e-mails and transferring e-mails by using display 338, as shown in Fig. 8, 9 & 10 for setting up preferences in filtering e-mails and forwarding (for storing). This BRG module is a part of the set top box, refer to col. 4/lines 25-52, and importantly, each set top box needs to have a subscriber identity module or SIM card for retrieving setup information and user related information and the e-mail message can be stored locally in the set top box, refer to col. 22/line 58 to col. 23/line 22 & col. 34/lines 20-57 for terminal configurations.

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In addition, Figure 3 also further discloses many processors P1-P6 for processing services and applications, refer to col. 21/line 54 to col. 22/line 36 using the display with on-screen icons for retrieving a pending voicemail and/or multimedia mail message (col. 22/lines 37-60).

Therefore, the examiner respectfully disagrees with the applicant's arguments, and Kung meets each and every limitations of pending claims as previously disclosed and now modified and explained in a more detailed and supportive final office action.

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

Alexandria, VA 22313-1451

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**or faxed to:**

(571) 273-8300.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:00 AM to 6:30 PM, with alternate Fridays off.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kieu-Oanh Bui  
Primary Examiner  
Art Unit 2611

KB  
August 01, 2005